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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,405	01/04/2000	TATSUYA FUJIKI	1442.1007	9196

21171 7590 01/11/2002

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EXAMINER

LEA EDMONDS, LISA S

ART UNIT PAPER NUMBER

2835

DATE MAILED: 01/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/477,405		FUJIKI ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Lisa Lea-Edmonds		2835	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s): _____  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

1. Figure 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanagisawa et al.. With respect to claims 1-5, and 7-14, Yanagisawa et al. teaches a function expanding device (300) comprising a first connection (312a, 312b, 324, 325,

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326) being connectable to a unit which expands a function of electronic hardware (100); a second connection part (321) being connectable to the electronic hardware; an operation part for the unit; and a display part (351) as claimed. Also, Yanagisawa et al. teaches a port replicator (200) having a third connection part (222) being connectable to the second connection part of the function expanding device; and a fourth connection part (221) being connectable to the electronic hardware (100) as claimed (see for example figures 1-15 and column 4 line 27 through column 16 line 4). With respect to the control part as claimed, the apparatus of Yanagisawa et al. is silent on the matters. However, the control part is inherent to a computer system having a drive unit. It is well known in the art for a drive unit of any kind to have at least one control part such as a play, a on/off, a stop, an eject, and/or open/close key etc..

4. Claims 1-4, 6-9, and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Agata et al.. With respect to claims 1-4, 6-9, and 11-14, Agata et al. teaches a function expanding device comprising a first connection (412, 432) being connectable to a unit (130, 450, 460, 470) which expands a function of electronic hardware (100); a second connection part (414, 420) being connectable to the electronic hardware; a cable (410, 430); a display part (120); a third connection part (534) as claimed (see for example figures 1-6 and column 1 line 13 through column 8 line 48). With respect to the operation part and the control part as claimed; the apparatus of Agata et al. is silent on these matters. However, both the operation and control parts are inherent to a computer system having a drive unit. It is well known in the art for a drive unit of any kind to have at least one control part such as a play, a

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on/off, a stop, an eject, and/or open/close key. It is also well known in the art for a computer system and/or a drive unit to have circuitry inherent to the system used for operating the drive unit such as a processor and data bus lines.

*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please note the function expanding device; the port replicator and/or the computer device of Belt et al., Dohi et al., Hosoi et al., Densham et al., You et al., Lee et al., Hanebuth Lindberg et al., Friend et al., and Herron et al..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Lea-Edmonds whose telephone number is 703-305-0265. The examiner can normally be reached on 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 703-308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1782.

Lisa Lea-Edmonds  
Examiner  
Art Unit 2835

LL-E  
January 9, 2002

Supervisory  
D. Schubert  
DARREN SCHUBERT  
PRIMARY EXAMINER  
A.U. 2835